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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,816	07/28/2003	Robert Metzger	5490-000331	5865

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EXAMINER
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DAVIS, DANIEL J

ART UNIT	PAPER NUMBER
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3733

DATE MAILED: 05/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/628,816

Applicant(s)

METZGER, ROBERT

Examiner

D. Jacob Davis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 21-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 7/28/03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 7/28/03 7/12/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election with traverse of the restriction requirement in the reply filed on April 13, 2006 is acknowledged. The traversal is on the ground(s) that the restricted groups are similar and therefore the search should be "essentially coextensive." This is not found persuasive because the groups are distinctly classified resulting in a separate status in the art.

The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. At least claims 1-3, 9, 12, 13, 19 and 20 positively recite the device relative to the bone, constituting non-statutory subject matter. For example, claim 1 recites, "a positioning member fixed relative to the selected bone portion." Claim 2 recites, "said positioning member is disposed within the selected bone portion." Examiner suggests amending the claims using language such as, "adapted to be...", "constructed to be...", "designed to be...", etc.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 8, 9, 12-14, 16 and 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,952,213 to Bowman et al. Bowman discloses in figure 1 a positioning member 66, a guiding member 56 and a resecting member 40. The device further includes a selection portion 58 and a fixable sleeve 72.

Respecting claim 12, the device comprises a positioning rod 142, a first guiding member 56, a resecting tool 40, and a second guiding assembly 58 and 72. The positioning rod includes a bone engaging section 144 and a first guiding member engaging section located adjacent to arrow 142. The resecting head is movable along the axis of the resecting tool. The device includes a sleeve 80 and a stop 46.

Claims 1, 4 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,556,399 to Huebner. Huebner discloses in figure 1 a positioning member 32, a guiding member 12a, and a resecting member 12. The guiding member guides the resecting member into position. The guiding member 12a rotatably mates with the positioning member 32. The resecting member has a shaft including the proximal portion of 12 and a tool 10. As stated in column 5, lines 34-36 and lines 43-48,

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the tool has a diameter between 8 and 12 mm, which is within the required "about 0.5 and about 3.0 mm." The shaft 12 has the same dimensions as the tool 10 and therefore has a width "of about 0.25 cm to 2.0 cm." The outer portion of the positioning member is "approximately 22 mm" (column 5, line 46) which is "a width of about .5 to 2.0 cm."

Claims 1, 6 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,409,489 to Sioufi. Sioufi discloses in figure 2 a positioning member 45, a guiding member 1 rotatably extending from the positioning member, and a resecting member 23 rotatable with respect to the positioning member via the guiding member 1. The device includes a first portion 53 and a second portion 51. The device further comprises a second guiding member 35 and 39 enabling radial translation relative to the positioning member.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. Jacob Davis whose telephone number is (571) 272-4693. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo C. Robert can be reached on (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DJD



EDUARDO C. ROBERT  
SUPERVISORY PATENT EXAMINER